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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,792	05/09/2006	Marc Husemann	101769-315	4883
27384 7590 10/14/2009 NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER				
REDDY, KARUNA P				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
10/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,792

Applicant(s)

HUSEMANN ET AL.

Examiner

KARUNA P. REDDY

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-12,14-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-12,14-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 9/11/2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection via a non-final action are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

2. Claims 1-6, 9-12, 14-17 and 19-20 are currently pending in the application.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

4. Claims 1-2, 4-6, 9-11, 14-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al (5,910,522) in view of Prucker et al (Macromolecules 1998, 31, 602-613).

Schmidt et al disclose an adhesive comprising a transparent polymer and/or polymerizable oligomer and/or polymerizable monomer suitable for use as an adhesive, nanoscale inorganic particles and optionally compounds for surface modification of said inorganic particles (column 8, claim 1). Polymers that can be preferably employed as transparent polymers include polyacrylates and polymethacrylate. Instead of the mentioned polymers, oligomers and/or precursors (monomers) thereof may be employed as well (column 3, lines 39-61). The listing of nanoscale inorganic particles includes silicates and SiO₂ (column 4, line 6-10) which has a particle size preferably from 2 to 50 nm and particularly 5 to 20 nm (column 4, lines 36-37). Suitable surface modifier, i.e. surface modifying low molecular weight compounds have at least one functional group capable of reacting with groups present on the surface of powdered particles. Thus, an acid/base reaction may take place between the functional groups of surface modifying compound and surface groups of particles (column 5, lines 29-48). Examples of surface modifier compounds include mono and polycarboxylic acids having 1 to 12 carbon atoms such as acrylic acid and methacrylic acid as well as their esters e.g. methyl methacrylate (column 5, lines 55-63).

The nanoscale particles may be dispersed in one of the solvents and one of the polymerizable compounds (col. 6, lines 34-37). The polymer and polymerizable compounds may be dissolved in or mixed into a stable dispersion of the nanoscale

particles, optionally with addition of the surface modifying substances (column 6, lines 44-48). If polymerizable compounds are used, the adhesive also contains thermal or photochemical crosslinking initiators (column 6, lines 49-54). If the adhesive contains a crosslinkable compound, said compound is crosslinked and cured thermally and/or by irradiation depending on the type of crosslinking initiator employed (column 7, lines 19-24). Examples of thermal initiators include azobisisobutyronitrile, dibenzoyl peroxide and t-butylperbenzoate (column 7, lines 1-6). Examples of photoinitiators include 1-hydroxycyclohexylphenyl ketone and others (col. 6, lines 55-67) which reads on double bond functionalized photoinitiator of instant claims. Curing conditions (UV wavelength) depend on the decomposition conditions of crosslinking initiator (col. 7, lines 25-27). It is noted that UV wavelength encompasses UV irradiation in the range of from 200 to 400 nm of instant claims.

A working example of the preparation of adhesive includes mixing methyl methacrylate, SiO_2 and styrene (column 7, lines 53-56). The density of methyl methacrylate and styrene is 0.933 g/cm^3 and 0.907 g/cm^3 respectively (Knovel critical tables - Publication 2003). Therefore, ratio of methyl methacrylate and styrene in working example will read on the weight percentages used in claim 4. The finished adhesive is applied onto a substrate or said substrate is dipped into said adhesive (column 7, lines 13-14).

Schmidt et al is silent with respect to coating of filler (i.e. silicate and/or silica gel) with polyacrylate that is chemically bonded to a free-radical initiator which free radical initiator is chemically bonded to silicate and/or silica gel.

However, Prucker et al teach that grafting of polymer on solid surface by reaction of functional group of the preformed polymer with a corresponding site on the surface of

substrate is hampered by intrinsic limitation of the graft density and accordingly layer thickness due to strong kinetic hindrance for the attachment of polymer molecules once the surface is significantly covered. Several studies are done wherein the initiators are attached to the surface of solid substrates (page 602, col. 1, lines 1-21). See figure 1 of Prucker et al, wherein reaction scheme shows covalently attached polymer monolayers on silica surfaces using immobilized AIBN-type azo initiators. Therefore, in light of the teachings in Prucker et al, it would have been obvious to one skilled in art at the time invention was made to attach the azo initiator, of Schmidt et al, to surface of solid materials, such as the nanoparticulate silicates and SiO_2 of Schmidt et al, and polymerize the monomers of Schmidt et al (i.e. acrylic acid and methacrylic acid), because Schmidt et al contemplates surface modification of nanoparticles with polymers and Prucker et al has shown that graft density and accordingly layer thickness of polymer on the solid surface can be controlled by attaching initiator to the solid surface and then polymerizing monomer on the said surface, and one of ordinary skill in art would expect such a modification to work for the nanoparticle of Schmidt et al, motivated by expectation of success.

5. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al (5,910,522) in view of Prucker et al (Macromolecules 1998, 31, 602-613), as evidenced by Knovel (Knovel critical tables - Publication 2003).

The discussion with respect to Schmidt et al in paragraph 3 above is incorporated herein by reference.

Schmidt et al is silent with respect to weight fraction of polyacrylate coated particles of silicate and/or silica gel.

However, the proportion of nanoscale particles in adhesive composition of Schmidt et al is from 1 to 50 % by volume (column 4, lines 55-56) and weight fraction of instant claim is from 0.5 to 25. The density of inorganic silicates varies over a wide range from 2.0 to 6.5. Therefore, volume percentages of silicate in Schmidt et al encompasses weight fraction of present claim.

Response to Arguments

6. The rejection under 35 U.S.C. § 103 as set forth in paragraph 4 in the preceding office action mailed 9/11/2008 is hereby overcome in light of the statement of obligation to assign the instant application and Husemann et al (US 6,958,186 B2), at the time present invention was made, to tesa Aktiengesellschaft.
7. The rejection under 35 U.S.C. § 103 as set forth in paragraphs 3 and 5 in the preceding office action mailed 9/11/2008 is moot in view of the new grounds of rejection set forth in paragraphs 3 and 4 above.

While the grounds of rejection are changed, it was still deemed appropriate to address some of the arguments which would be pertinent to new grounds of rejection in this office action (See paragraph 8 below).

8. Applicant's arguments filed 9/11/2009 have been fully considered but they are not persuasive. Specifically, applicant argues that (A) although "pressure sensitive adhesive" appears in the preamble, it is not a mere statement of intended use that can be ignored, but rather a statement of structure. Schmidt describes hardening adhesives

and not pressure sensitive adhesives; (B) persons skilled in the art must make a number of selections within Schmidt's disclosure to arrive at the instant claims - polyacrylates from a large number of polymers, silicate or silica gel as the filler, small size of the filler.

With respect to (A), it is the examiner's position, that compositional requirements of instant claims are met by the teachings in Schmidt et al in view of Prucker et al and its use as pressure sensitive adhesive is an intended use of the composition of Schmidt et al in view of Prucker et al.

With respect to (B), applicant's attention is drawn to Schmidt et al wherein it states - polymers particularly preferred are transparent polymers such as polyacrylates and PMMA (col. 3, lines 58-60); SiO₂ particles show additional advantage of a thixotropic effect when being dispersed in a polymer matrix (col. 4, lines 38-44); and nanoparticles preferably have a size of 2 to 50 nm and particularly 5 to 20 nm (col. 4, lines 36-38).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARUNA P. REDDY whose telephone number is (571)272-6566. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. P. R./
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796